

Remarks:

Claims 18-43, 45-46 and 48-55 are pending in the application. Claims 21-23, 31-43, 45, 46 and 48-53 have been withdrawing from consideration. Since claim 18 is a generic claim to spices claims 21-23, when claim 18 is found allowable, the merits of claims 21-23 should be examined.

Applicants have not amended any of the above-listed claims.

Claim Rejections under 35 USC 103

Claims 18, 19, 20, 24, 26-29 and 54 are rejected under 35 USC 103(a) as being unpatentable over Holman (US Patent No. 5,287,181) in view of official notices. Applicants believe that in concluding that the claims are obvious, the Examiner erred both factually and legally. Under *Graham v. John Deere*, the Examiner needs to at least: (i) determine the scope and content of the prior art; and (ii) ascertaining the differences between the claimed invention and the prior art. The Examiner fails to identify the differences between the claimed invention and Holman.

First, claim 18 recites "request sender configured to transmit the user request for incentive information, which is receivable by a management system". In Holman, incentive information is coded in the television signals. (col. 4, lines 11-26). The Holman home unit does not request incentive information but just passively decodes the incentive information in the television signals. (col. 9, lines 33-41).

Second, claim 18 recites "incentive information receiver configured to receive the incentive information **returned from the management system**". As is clear from the language of claim 18 which distinguishes the broadcast station and the management system, the incentive information of the present invention comes not from a TV broadcasting station but is returned from the management system in response to a request from the mobile terminal. On the other hand, as explained above, the Holman home unit just passively decodes the incentive information in the TV signals sent from the broadcasting station.

Third, claim 18 requires the mobile terminal to have two interfaces: an interactive device interface; and a mobile communication network interface. Applicants do not believe that the home unit of Holman has a mobile communication network interface to

enable the home unit to communicate with a service facility that provides the service.

Lastly, Holman is silent about an incentive information presenter configured to present the stored incentive information to the service facility in order to receive the promoted service from the service facility. In this regard, the Examiner determined that "incentive information presenter" can read on a card of Holman. A card does not present information but is just read. In Holman, a user brings the card and presents it to a retail store. On the other hand, claim 18 specifically calls for the mobile terminal to present the incentive information.

The Examiner is not only factually wrong in ignoring the above differences between the claimed invention and Holman, but also legally wrong in just presenting the conclusion, without more, that the Holman home unit could have been replaced with a portable phone. Rejections on obviousness grounds cannot be sustained by mere conclusionary statements. There must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

The Examiner understands *KSR* wrongly. The Examiner quoted from *KSR* that the combination of familiar elements according to known methods is likely to be obvious when it does not more than yield predictable results. This language from *KSR* unequivocally suggests that the *KSR* holding does not apply to the claimed invention as a whole but applies to each of the claim limitations individually. Under *KSR*, thus, the Examiner must analyze each claim limitation to be combined individually in order to determine whether the claim limitation to be combined was a familiar element and could have been combined by a known method. The Examiner failed to do this in the Office Action.

In the Office Action, the Examiner jumped to the conclusion that the Holman home unit could have been replaced with a portable phone. As discussed above, the Examiner's process of getting to the conclusion is wrong. Also, Applicants cannot accept the conclusion itself. The Holman home unit has physical connections with a STB, a VICR and a TV. It is equipped with a printer and a card reader/writer. It does not have any communication capabilities except receiving TV signals and decoding messages coded in the TV signals. It is nothing but a self-serving and hindsight statement that the Holman home unit could have been replaced with a portable phone.

In sum, Applicants respectfully request that the Examiner identify the differences between the claimed invention and Holman according to *Graham* and if the Examiner wants to introduce missing claim limitations from other references, analyze the claim limitations individually according to *KSR* to see whether the claim limitations could have been combined by known methods.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Tadashi Horie', is written over a horizontal line.

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